

- - REMARKS - -

Applicant requests the Examiner clarify that all references cited in Applicant's previously filed Information Disclosure Statement have been considered. The Examiner's "J" mark on Applicants' 1449 is potentially ambiguous, and does not cover the citation to Jovicic, US 5,885,007.

A. Claims 11-21 were objected to

The objection to claims 11-21 has been obviated by amendment to correct typographical errors, and not to avoid any reference. Withdrawal of the objections to claims 11-21 is requested.

B. Claims 1-21 were rejected under §112 as "ambiguous and confusing for failing to accomplish the desired goal stated in the preambles".

The rejection of claims 1-21 as unpatentable under 35 U.S.C §112 is traversed.

The Examiner's rejection and the grounds cited are unfounded in law or fact, and the Applicants respectfully request the Examiner consider the claim language. Specifically, the fact that the Examiner argues that "the body of the claim discloses steps that are usually associated with the issuance of a coupon redeemable on a promoted product (and these steps are implicitly supported in any coupon issuance system and need

not be explicitly recited therein)” illustrates that the Examiner has not actually read these claims.

§112/2 has two separate requirements:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

The Examiner fails to state exactly which leg forms the ‘support’ for the rejection, and merely argues that the claim elements do not accomplish the desired goal stated in the preambles. However, the Examiner does not offer an iota of evidence of how these claims do not accomplish “resetting the value of a coupon,” or any citation to support an argument that “failure to accomplish” a “goal” recited in a preamble has any affect whatsoever on patentability. The Examiner fails to even correctly recite the preambles stated in the claims.

The Examiner further alleges that because “the body of the claim fails to achieve the stated goal featured in the preamble section” that “the Applicant has failed to particularly claim the subject matter for which he is seeking patent protection.” Again, Applicants dispute the Examiner’s characterization of the claim, but note that even if the Examiner were correct, such a fact would not support the Examiner’s rejection.

With respect to the Examiner’s rejection of claim 21 as “confusing”, the Applicant notes that the “means for” language is well known as language invoking the strictures of 35 U.S.C. §112 paragraph 6. Thus, claim 21 cannot possibly be considered “confusing” as the recitation of “means for” is well known in patent practice. Further, merely combining the phrase “means for” within a claim that recites means plus function is not problematic and the Examiner fails to cite any authority to support such an allegation.

Withdrawal of the rejections to claims 1-21 under §112 is requested.

C. Claims 1-21 were rejected as anticipated under §102(e) by Barnett and under §102(b) by Spector and Lemon.

The anticipation rejections over Barnett, Lemon, and Spector are traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1989). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1990).

At a minimum, Barnett, Lemon, and Spector fail to disclose “receiving a request for valuation of a coupon from a retailer” as claimed in claims 1, 11 and 21. In fact, the Examiner makes no attempt to even argue that any of the references discloses such a claim element, arguing only that:

(The steps recited in at least the independent claims are implicitly supported in any coupon issuance system and are performed prior to the distribution of a coupon or before a promotional campaign begins and may not be explicitly recited therein).

The Examiner is flatly mistaken. First, it is both physically and logically impossible to receive a “request for valuation of a coupon from a retailer” prior to distribution of a coupon. Since the claim language requires receiving the “request for valuation” from a retailer, the coupon *must have been previously distributed*.

Therefore, the Examiner's argument is wholly and utterly misplaced. Regardless of the benefits of the disclosures of Barnett, Lemon, and Spector, each reference is directed to distribution of coupons, and not their valuation, or activities post-distribution or activities during redemption of coupons at a retailer. Specifically, Barnett discloses a method and system for electronic distribution of product redemption coupons, while Spector discloses a computer-controlled system including a printer-dispenser for merchandise coupons, and Lemon discloses a method and apparatus for controlling the distribution of coupons.

None of these references even disclose the problems that the instant claims address – the potential time lag between a decision on the value of the coupon, and the use of that coupon. As noted in the specification of this case, during this time lag, market conditions can change, and the coupon value may be too high for market conditions, or too low for market conditions. See, paragraphs 4 and 5 of the specification.

Just as the references fail to disclose “receiving a request for valuation of a coupon from a retailer”, each reference additionally fails to disclose “accessing market demand information for a product corresponding to the coupon in response to the request”, as well as “determining a market demand value based on the market demand information”, “determining a coupon value based on the market demand value” and “providing the coupon value to the retailer.”

Claims 2-10 depend directly or indirectly from claim 1 and claims 12-20 depend directly or indirectly from claim 11. Therefore each claim is allowable for at least the same reasons as claim 1, 11, and 21. Withdrawal of the anticipation rejections to claims 1-21 is requested.

CONCLUSION

The Applicants respectfully submit that claims 1-21 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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